



FEB 19 2002

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 11, 25, 31, 32 and 49 of the morning section and questions 36 and 49 of the afternoon section of the Registration Examination held on April 18, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 66. On June 22, 2001, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and

37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the

answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional two points for afternoon questions 36 and 49. Accordingly, petitioner has been granted an additional two points on the Examination. No credit has been awarded for morning questions 11, 25, 31, 32 and 49. Petitioner's arguments for these questions are addressed individually below.

Morning question 11 reads as follows:

11. Registered practitioner Ethel prepares a utility patent application (not a CPA) for inventor Fred, using her only copy of a published article, "Engineering Design," published June 8, 1995, to draft the application. Thereafter, Ethel accidentally runs the copy of the article through her paper shredder. Ethel duly files the application in the USPTO on May 29, 1999. The examiner sends Ethel a non-final Office action dated December 7, 2000, setting a three-month period for reply, including a rejection of claim 1 and a requirement for information under 37 CFR § 1.105 requiring her to submit a copy of the article, "Engineering Design." Which of the following will properly be accepted by the USPTO as a complete reply to the requirement for information?

(A) An information disclosure statement, filed by Ethel on Monday, January 15, 2001, that complies with the provisions of 37 CFR § 1.98, listing a foreign patent, and stating that each item of information contained in the information disclosure statement was first

cited in a communication from a foreign patent office less than three months prior to the filing of the information disclosure statement.

(B) A statement filed by Ethel on Wednesday, March 7, 2001, stating that Ethel is not an individual identified under 37 CFR § 1.56(c).

(C) A statement filed by Ethel on Thursday, March 8, 2001, with the appropriate petition and fee for a one-month extension, that states that the information required to be submitted is not readily available to the party from which it was requested.

(D) A statement filed by Ethel on Thursday, March 8, 2001, with the appropriate petition and fee for a one month extension, which states that Ethel has a good faith belief that the information required is not material to patentability.

(E) None of the above.

The model answer is selection (C).

37 CFR § 1.105(a)(3) (effective November 7, 2000), "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54634 (September 8, 2000), and 37 CFR § 1.136(a)(1). (C) is correct pursuant to 37 CFR § 1.105(a)(3). (A) is incorrect because it is not responsive to the requirement for information. (B) is incorrect because "each attorney or agent who prepares or prosecutes the application," is identified an individual under 37 CFR § 1.56(c). (D) is incorrect because information used to draft an application may be required under 37 CFR § 1.105(a)(1)(iv). (E) is incorrect because (C) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that applicant fails to respond to the rejection.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that applicant fails to respond to the rejection, the question asks "Which of the following will properly be accepted by the USPTO as a complete reply to the requirement for information?" (C) is correct pursuant to 37 CFR § 1.105(a)(3). The question does not ask about the rejection or the reply as a whole, but explicitly and specifically restricts its scope to the requirement for information. Accordingly, model answer (C) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 25 reads as follows:

25. Which of the following is not in accordance with proper USPTO practice and procedure?

(A) Conversion of a provisional application to a nonprovisional application will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application.

(B) Conversion of a provisional application to a nonprovisional application cannot adversely impact on the term of any patent to issue from the application.

(C) An applicant having filed a provisional application can avoid any adverse patent term impact resulting from converting the provisional application to a nonprovisional application by instead filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. § 119(e).

(D) An applicant filing a nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 C.F.R. § 1.78 of an earlier provisional application, and not requesting conversion of the provisional to a nonprovisional application can avoid the fee required to convert a provisional application to a nonprovisional application, as well as an adverse patent term effect that would result from a conversion.

(E) The twelve month period of pendency of a provisional application extends to the next secular or business day which is not a Saturday, Sunday, or Federal holiday in the District of Columbia if the day that is twelve months after the filing date of the provisional application under 35 U.S.C. § 111(b) and 37 C.F.R. § 1.53(c) falls on a Saturday, Sunday, or a Federal holiday in the District of Columbia.

The model answer is selection (B).

As stated in "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092 (Aug. 16, 2000), 1238 O.G.13 (Sept. 5, 2000), "Section 4801 of the American Inventors Protection Act of 1999 contains no provision for according the resulting nonprovisional application a filing date other than the original filing date of the provisional application. Thus, under the patent term provisions of 35 U.S.C. 154, the term of a nonprovisional application resulting from the conversion of a provisional application pursuant to 35 U.S.C. § 111(b)(5) will be measured from the original filing date of the provisional application (which is the filing date accorded the nonprovisional application resulting from the conversion under § 4801 of the American Inventors Protection Act of 1999)." However, the pendency is counted against the patent term. (A), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3), third sentence. See also, "Request for

Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50093 (Aug. 16, 2000), 1238 O.G.13 (Sept. 5, 2000). (C), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3), fourth sentence. (D), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3). (E) is a correct statement, and therefore is not a correct answer. 35 U.S.C. § 119(e)(3).

Petitioner argues that answer (A) is correct. Petitioner contends that the answer is flawed by ambiguity of the terms "at least" and "adversely effect".

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the answer is flawed by ambiguity of the terms "at least" and "adversely effect", "at least" in selection (A) is explicitly modifying the phrase "the filing date of the provisional application" and "adversely effect" does not occur at all in the question, although the term "adversely impact" explicitly modifies the phrase "on the term of any patent to issue from the application." (A), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3), third sentence. See also, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50093 (Aug. 16, 2000), 1238 O.G.13 (Sept. 5, 2000). The answer in (B) is clearly not in accord with USPTO practice and procedure because a reduction in patent term is per se an adverse impact on a patent term. Accordingly, model answer (B) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 31 reads as follows:

31. Which of the following statements is correct regarding an antedating declaration or affidavit being used in accordance with proper USPTO practice and procedure?

- (A) Where the reference publication date is more than one year before applicant's effective filing date.
- (B) Where the reference is a prior U.S. patent to the same entity, claiming the same invention.
- (C) Where the subject matter relied on in the reference is prior art under 35 U.S.C. § 102(g).
- (D) Where the reference, a U.S. Patent, with a patent issue date less than one year prior to

applicant's effective filing date, shows but does not claim the same patentable invention.

(E) Where the effective filing date of applicant's parent application or an International Convention-proved filing date is prior to the effective date of the reference.

The model answer is selection (D).

35 U.S.C. § 102(a); MPEP § 715, subsection styled "SITUATIONS WHERE 37 C.F.R. 1.131 AFFIDAVITS OR DECLARATIONS CAN BE USED." (A) is incorrect. 35 U.S.C. 102(b), MPEP § 715. (B) is incorrect. The question involved is one of "double patenting." 37 C.F.R. § 1.131, MPEP § 715. (C) is incorrect. 35 U.S.C. § 102(g); 37 C.F.R. § 1.131. As explained in MPEP § 715, subsection styled "SITUATIONS WHERE 37 C.F.R. 1.131 AFFIDAVITS OR DECLARATIONS ARE INAPPROPRIATE," "i. ... 37 C.F.R. 1.131 is designed to permit an applicant to overcome rejections under 35 U.S.C. 102(a) and (e) based on patents and publications which are not statutory bars, but which have publication dates, or in the case of U.S. patents, effective filing dates, prior to the effective filing date of the application but subsequent to the applicant's actual date of invention. However, when the subject matter relied on is also available under 35 U.S.C. 102(g), a 37 C.F.R. 1.131 affidavit or declaration cannot be used to overcome it. In re Bass, 474 F.2d 1276, 177 USPQ 178 (CCPA 1973). This is because subject matter which is available under 35 U.S.C. 102(g) by definition must have been made before the applicant made his invention. References under 35 U.S.C. 102(a) and (e), by contrast, merely establish a presumption that their subject matter was made before applicant's invention date. It is this presumption which may be rebutted by evidence submitted under 37 C.F.R. 1.131." (E) is incorrect. An affidavit or declaration under 37 C.F.R. 1.131 is unnecessary because the reference is not prior art and should not be used. MPEP § 715.

Petitioner argues that answer (C) is correct. Petitioner contends that one of the declarations or petitions under 37 CFR 1.130, 1.131 or 1.132 can be used to overcome a 35 USC 102(g) rejection.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that one of the declarations or petitions under 37 CFR 1.130, 1.131 or 1.132 can be used to overcome a 35 USC 102(g) rejection, petitioner offers no substantiation for this assertion. As explained in MPEP § 715, subsection styled "SITUATIONS WHERE 37 C.F.R. 1.131 AFFIDAVITS OR DECLARATIONS ARE INAPPROPRIATE," "i. ... 37 C.F.R. 1.131 is designed to permit an applicant to overcome rejections under 35 U.S.C. 102(a) and (e) based on patents and publications which are not statutory bars, but which have publication dates, or in the case of U.S. patents, effective filing dates, prior to the effective filing date of the application but subsequent to the applicant's actual date of invention. However, when the subject matter relied on is also available under 35 U.S.C. 102(g), a 37 C.F.R. 1.131 affidavit or

declaration cannot be used to overcome it. In re Bass, 474 F.2d 1276, 177 USPQ 178 (CCPA 1973). This is because subject matter which is available under 35 U.S.C. 102(g) by definition must have been made before the applicant made his invention. References under 35 U.S.C. 102(a) and (e), by contrast, merely establish a presumption that their subject matter was made before applicant's invention date. It is this presumption which may be rebutted by evidence submitted under 37 C.F.R. 1.131." Neither 37 CFR 1.130 or 1.132, suggested by the petitioner as being alternatives to 37 CFR 1.131, are relevant to antedating declarations or affidavits. Accordingly, model answer (D) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 32 reads as follows:

32. Which of the following is in accordance with proper USPTO practice and procedure?

(A) After issuance of a notice of allowance in November 2000, a petition to withdraw an application from issue and requisite fee are required if a request for continued examination, submission, and requisite fee are filed prior to the issuance of the patent.

(B) After issuance of a notice of allowance in April 2001 for an application, an amendment of the claims in the application may be filed before, with, or after payment of the issue fee.

(C) The Office ensures that any petition to withdraw an application from issue, filed after payment of the issue fee, will be acted upon prior to the scheduled date of patent grant.

(D) If a request for continued examination under 37 CFR § 1.114, accompanied by the requisite fee, but not a submission, are filed in March 2001, after an application was allowed in January 2001, the Office will notify the applicant and set a time period within which the deficiency must be corrected.

(E) An amendment filed in the Office in April 2001 in reply to a final rejection must comply with either the provisions of 37 CFR § 1.114 or the provisions of 37 CFR § 1.116(b) and (c).

The model answer is selection (E).

37 C.F.R. §§ 1.114 and 1.116(b) and (c). See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50097, middle column, second complete paragraph, 50101, Comment 19 and

response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.313(a), third sentence. A petition under § 1.313 is not required if a request for continued examination is filed prior to payment of the issue fee. (B) is not the most correct answer. 37 C.F.R. § 1.312, in pertinent part, provides, "Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee." See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50097, middle column, fourth complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not correct. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50097, right column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). See also 37 CFR § 1.313(d). (D) is not the most correct answer. "The Office will not suspend action in an application when a reply by the applicant is outstanding. 35 U.S.C. 133 requires the applicant to 'prosecute the application' within six months of an Office action (or a shorter period as set in the Office action) to avoid abandonment of the application. If an applicant files a request for continued examination but does not also provide any submission (in reply to the prior Office action) within the period for reply to the prior Office action, the application is abandoned by operation of law. (35 U.S.C. 133)." See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50102, left column, Comment 20 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

Petitioner argues that answer (A) is correct. Petitioner contends that selection (A) does not state that the RCE was filed before the issue fee was paid.

Petitioner's arguments have been fully considered but are not persuasive. Petitioner's statement that selection (A) does not state that the RCE was filed before the issue fee was paid is not relevant because selection (A) states "After issuance of a notice of allowance in November 2000, a petition to withdraw an application from issue and requisite fee are required if a request for continued examination, submission, and requisite fee are filed prior to the issuance of the patent." If there are any circumstances where the petition to withdraw is not required, then (A) is incorrect. The petition to withdraw is not required in the circumstance that the issue fee has not been paid. On the other hand, (E) is correct because of 37 C.F.R. §§ 1.114 and 1.116(b) and (c). See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50097, middle column, second complete paragraph, 50101, Comment 19 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). Accordingly, model answer (E) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 49 reads as follows:

49. In regard to disclosure of a utility in a nonprovisional utility patent application filed in the Office in April 2001, which of the following is not in accord with proper USPTO practice and procedure?

- (A) For each claimed invention an applicant need only provide one credible assertion of specific and substantial utility to satisfy the utility requirement.
- (B) A patent examiner can properly support a rejection based on lack of utility by providing documentary evidence regardless of the publication date to show a factual basis for the prima facie showing of no specific and substantial credible utility.
- (C) Using a complex claimed invention as landfill is an example of a specific and substantial utility for the claimed invention.
- (D) An invention has a well-established utility if a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention, and the utility is specific, substantial, and credible.
- (E) Where the asserted specific and substantial utility is not credible, a prima facie showing of no specific and substantial utility must establish that it is more likely than not that a person skilled in the art would not consider credible any specific and substantial utility asserted by the applicant for the claimed invention.

The model answer is selection (C).

See, "Utility Examination Guidelines," 66 F.R. 1092, 1098, left column (Jan. 5, 2001), "A claimed invention must have a specific and substantial utility. This requirement excludes 'throw-away,' 'insubstantial,' or 'nonspecific' utilities, such as the use of a complex invention as landfill, as a way of satisfying the utility requirement of 35 U.S.C. 101." (A) is not the most correct answer. See, "Utility Examination Guidelines," 66 F.R. 1092, 1097, middle column (Jan. 5, 2001), "An applicant need only provide one credible assertion of specific utility for each claimed invention to satisfy the utility requirement." (B) is not the most correct answer. See, "Utility Examination Guidelines," 66 F.R. 1092, 1098, middle column (Jan. 5, 2001), "Any rejection based on lack of utility should include a detailed explanation why the claimed invention has no specific and substantial credible utility. Whenever possible, the examiner should provide documentary evidence regardless of publication date (e.g., scientific or technical journals, excerpts from treatises or books, or U.S. or foreign patents) to support a factual basis for the prima facie showing of no specific and substantial credible utility." (D) is not the most correct answer. See, "Utility Examination Guidelines," 66 F.R. 1092, 1098, left column (Jan. 5, 2001),

wherein it states, "An invention has a well-established utility (1) if a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (e.g., properties or applications of a produce or process), and (2) the utility is specific, substantial, and credible." (E) is not the most correct answer. See, "Utility Examination Guidelines," 66 F.R. 1092, 1098 right column (Jan. 5, 2001), which states what is recited in (E).

Petitioner argues that answer (B) is correct. Petitioner contends that answer (B) fails to include a detailed explanation of why the claimed invention has no specific and substantial credible utility, whereas a complex invention used as landfill could reduce odor or facilitate decomposition.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer (B) fails to include a detailed explanation of why the claimed invention has no specific and substantial credible utility, whereas a complex invention used as landfill could reduce odor or facilitate decomposition, selection (B) only states that "A patent examiner can properly support a rejection" and does not indicate that is the total rejection whereas there is no specification in the fact pattern for (C) that a complex invention had utility to reduce odor or facilitate decomposition. Accordingly, model answer (C) is correct and petitioner's answer (B) is incorrect.

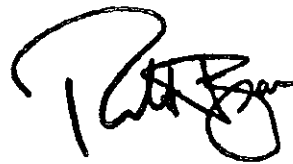
No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, two points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above the printed name and title.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy